

REMARKS

In this application, claims 1-35 are rejected under 35 U.S.C. § 103 (a). Claims 1-21 are canceled, claims 22-35 are original, and claims 36-39 are new. Claims 1-21 have been canceled, and claims 22-35 are original.

Changes to the Claims:

New claims 36-38 have been added. The language of claims 36-38 are supported by the specification as originally filed. No new matter has been added.

Rejection under 35 U.S.C. § 102:

In the Office Action (OA), claims 22-23, 28-29, 31, 33, and 35 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Iwama (U.S. Patent No. 6,600,735, hereafter Iwama). Applicant contends that the pending claims recite features not disclosed in Iwama and therefore traverse the outstanding rejection.

Claim 22 recites the feature “said step of implementing call setup within said packet switched data network is carried out after information on a resources status in the second telephony network is available” (emphasis added). Applicants believe that the following correspondence of claim terms to the features of Iwama is helpful in comparing the claim language to the reference. Claim 22 recites the presence of first and second telephony networks bridged by a packet switched data network and recites steps for conducting setup for a telephone call to be conducted over this sequence of networks. With reference to Figure 1, Iwama discloses a first telephony network (PSTN network 104-a), a second telephony network (PSTN 104-b), and a packet-switched data network (Internet 110) bridging the two telephony/PSTN networks. The method steps disclosed in the OA are examined in light of the above correspondence.

The Examiner contends that Iwama’s step of “determining the destination gateway prior to sending the call” reads on the claimed feature of implementing call setup within said packet switched data network after information is available regarding the second telephony network. Applicants contend that Iwama’s step of “determining the destination gateway” occurs within the data network, that this step therefore does not correspond to the step of obtaining information about the second telephony/PSTN network of Iwama, and thus does not meet the limitations of claim 22. Applicants elaborate below.

The examiner appears to contend that “determining the destination gateway” corresponds to determining “the resources status in the second telephony network is available”, since the Examiner stresses that the above determining step is performed prior to “sending the call”. However, claim 22 requires that the earlier occurrence – that of resources status information becoming available – pertain to “the second telephony network”. The benefit of one aspect of Applicant’s invention is that the call is not set up in the packet switched data network unless the second telephony network is available.

In the primary embodiment of Iwama, the “second telephony network” would logically correspond to PSTN 104-b. However, the OA refers to the earlier step involving the “destination gateway”. Notably, however, the gateways 102 of Iwama are *not* in either of the PSTN networks, but rather within Iwama’s *data network*, that is, Internet 110. Thus, Iwama’s step of “determining the destination gateway” does *not* correspond to determining “a resources status in the second telephony network” language of claim 22. Thus, Iwama does not disclose the above-quoted limitation of claim 22.

Separately, Iwama describes a sequence of events for setting up a phone call between two PSTNs bridged by a data network that specifically contradicts the limitation of claim 22 in which call setup in the data network is implemented *after* information about the second telephony network is obtained. In the following, reference is made to Figures 1 and 3 of Iwama and the text in columns 8-9 thereof. Figure 1 of Iwama is a diagram of a communication system including two PSTNs bridged by a data network. Figure 3 is a sequence diagram of a call connection between a calling side PSTN terminal and a called side PSTN terminal. Figure 3 shows both the sequence of events in the call and the entities participating in the respective events. The preliminary steps are omitted in this section for the sake of brevity, but can be readily identified by viewing Figure 3 and the corresponding text of Iwama.

Iwama recites “the gateway device (102-a) notifies a call setup to the gateway device (102-b) according to the call establishment procedure of ITU-T H.323 shown in FIG. 2, for example (S306 to S309)” (emphasis added). See col. 8, line 64 to col. 9, line 1. Steps 306-309, discussed above, are illustrated in Figure 3. Notably, in Figure 3, no activity involving second telephony network PSTN 104-b prior to or during step 306-309 is shown. Iwama recites that, later in the call sequence, “gateway device . . *then* transmits the setup message to the *PSTN (104-b)*.¹” See col. 9, lines 1-5 (emphasis added). The foregoing confirms that the call setup in the data network of Iwama occurs *before any activity occurs* that involves the second telephony network of Iwama. Thus, the described operation of the Iwama system contradicts the above-quoted features of claim 22.

Claim 22 is thus patentable over Iwama under 35 U.S.C. § 102 (b). Claims 23, 28-29, 31, 33, and 35 depend from claim 22 and are patentable over claim 22 for the same reasons as claim 22. Thus claims 22-23, 28-29, 31, 33, and 35 are patentable over Iwama under 35 U.S.C. § 102 (b).

Rejection Under 35 U.S.C. § 103:

Claims 24-27, 30, 32, and 34 are rejected under 35 U.S.C. § 103 (a) as being obvious in light of Iwama in view of Elliott et al. (U.S. Patent 6,614,781, hereafter Elliott). Applicant has already shown that claim 22 recites features not disclosed in Iwama. Moreover, Elliott also does not disclose the pertinent features, which are discussed at length in the section above. Accordingly, claim 22 is patentable over the combination of Iwama and Elliott. Claims 24-27, 30, 32, and 34 depend from claim 22, inherit the features thereof, and are therefore also patentable over the combination of Iwama and Elliott under 35 U.S.C. § 103 (a).

New Claims 36-38:

New claim 36 depends on claim 22 and is patentable based on the patentability of claim 22. New claims 37-38 recite features related to those in claim 22 and other pending claims and are believed to be patentable for the same reasons as claim 22. The new claims are supported by the specification as filed. No new matter has been added.

Separately, Applicant notes that like the Elliott reference that was used to reject Applicant's claims in the Office Action preceding the current one, Iwama discloses setting up the routing of a call within its data network *before* doing the same in the second telephony network, in contrast to the claimed features of claim 22. Accordingly, Iwama is no closer to claimed invention than was Elliott. The M.P.E.P. recites that "switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection." See M.P.E.P. § 706.07.

Since the Applicant has shown the patentability of claim 22, in unchanged form, over a succession of references, in respective Office Actions, Applicant respectfully contends that the provisions of the above-quoted portion of the M.P.E.P. work in favor of allowing the present application.

Conclusion:

The present application is believed to be in condition for allowance. The Examiner is invited to call the undersigned if it is believed a discussion would be helpful in advancing the prosecution of this application. It is believed that no fees are due. However, the Examiner is authorized to deduct any fees believed due from, or to refund any overpayments to, Deposit Account No. 50-4711.

Respectfully submitted,

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